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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK D. ROBINSON, DAVID J. COLLEEN, and
LINDA R. JAMES

Appeal 2009-006883
Application 09/686,206
Technology Center 2400

Before ST. JOHN COURTENAY III, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-20 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

Appellants' invention relates to the field of computer interfaces, networking, e-commerce, and configurable websites. More particularly, the invention on appeal is directed to a system and method to configure and provide network-enabled three-dimensional computing environments. (See Spec. 2).

Representative Claim

1. A computer-implemented method comprising:

downloading a 3D (three dimensional) environment development program to a computer system from a Web server over the Internet;

executing the 3D development program within the computer system to convert a 2D (two dimensional) desktop environment of the computer system into a 3D computing environment, including installing an interpreter within an operating system of the computer system;

providing the 3D computing environment representing a 3D desktop of a computer system in a 3D environment which is presented as a 3D desktop in a 3D room environment, wherein one or more icons of the 2D desktop environment are spatially displayed on multiple surfaces of the 3D room environment;

receiving a two-dimensional application program;

the interpreter dynamically converting the two-dimensional application program to a form useable in the three-dimensional computing environment;

presenting content of the converted application program within the 3D computing environment to allow a user of the computer system to navigate the content of the application program within the 3D computing environment;

accessing a registry server over the Internet to download additional 3D graphical objects to be used in the 3D desktop, wherein the registry server is associated with an community having a plurality of members, and wherein the registry server is configured to maintain 3D graphical objects, including the downloaded 3D graphical object, used by the plurality of members including software updates to the 3D desktop;

storing the downloaded 3D graphical objects in a repository within the computer system, wherein the repository is configured to store all graphical objects used by the 3D desktop, including graphical objects downloaded over the Internet, updates from the registry server, and user defined objects defined locally by a user of the computer system.

Rejections

1. Claims 3-10 and 12-19 stand rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.
2. Claims 1 and 2 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 9 of Robinson (US Patent No. 7,168,051).
3. Claims 1-8 and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mackinlay (US Patent No. 6,088,032).¹
4. Claims 9-11 and 18-20 stand rejected under 35 U.S.C.

¹ Although the header of the rejection on page 8 of the Answer lists claims 1-20 as being rejected under § 103 over Mackinlay, the Examiner only presents rejections for claims 1-8 and 12-17 on pages 8-23 of the Answer. Claims 9-11 and 18-20 stand rejected under § 103 over the combination of Mackinlay and Fisher. (Ans. 23).

§ 103(a) as being unpatentable over Mackinlay and Fisher (US Patent App. 2001/0019332).

§ 112, first paragraph, written description

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal regarding the Examiner's factual findings under the written description requirement of §112, first paragraph:

Does the originally-filed Specification reasonably convey to the artisan that Appellants had possession of the claimed subject matter: (1) “wherein the 3D computing environment can be deactivated” and, (2) “without having to display the 2D desktop environment first?” (Claims 3 and 12).

35 U.S.C. § 112, first paragraph, written description requirement

As reaffirmed by the Federal Circuit:

“To satisfy the written description requirement, ‘the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but the description must clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’” *Carnegie Mellon Univ. v. Hoffmann La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed. Cir. 1996)). “In other words, the applicant must ‘convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate that by disclosure

in the specification of the patent.” *Id.* (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991)). Such disclosure need not recite the claimed invention *in haec verba*, but it must do more than merely disclose that which would render the claimed invention obvious. [*Univ. of*] *Rochester* [*v. G.D. Searle & Co.*], 358 F.3d [916] at 923 [(Fed. Cir. 2004)]; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566–67 (Fed. Cir. 1997); *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306–07 (Fed. Cir. 2008) (explaining that § 112, ¶1 “requires that the written description actually or inherently disclose the claim element”).

Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 560 F.3d 1366, 1371-1372 (Fed. Cir. 2009).

ANALYSIS

Appellants contend the present application describes a 3-D desktop that can be downloaded, installed, and activated to convert a conventional 2-D desktop into a 3-D desktop environment. (App. Br. 10). Appellants further contend that the Specification states that if a user chooses not to activate the 3-D desktop, the persistent client still operates and remains active to collect user information. (*Id.*).

At the outset, we particularly observe that Appellants attempt to improperly frame the written description issue as a question of whether the claims are *definite*. (App. Br. 10-11). Appellants’ contentions are misplaced because the Examiner did not reject the claims under § 112, second paragraph. Although Appellants point generally to pages 20-21 of the Specification (without mentioning specific line numbers), Appellants fail to

mention that the Specification (including pages 20-21) and claims 3 and 12 were amended by the Amendment filed on Dec. 13, 2007.

Regarding the negative limitation of “without having to display the 2D desktop environment first” (Claims 3 and 12), we note that our reviewing court has determined that an express intent to confer on the claim language the novel meaning imparted by the negative limitation is required, such as an express disclaimer or independent lexicography in the written description that provides support for the negative limitation. *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (citations omitted).

Here, Appellants have not pointed to an express disclaimer or independent lexicography in the originally-filed Specification that provides support for the negative limitation. On this record, Appellants’ arguments are unpersuasive of error regarding the Examiner’s factual findings under § 112, first paragraph (written description) (*See* Ans. 26-27). For essentially the same reasons argued by the Examiner (*Id.*), we agree that Appellants have not established that the originally-filed Specification (including the original claims and drawings) reasonably conveys possession of the disputed subject matter: (1) “wherein the 3D computing environment can be deactivated” and, (2) “without having to display the 2D desktop environment first.” (Claims 3 and 12).

Because Appellants have not met their burden of showing reversible error in the Examiner’s *prima facie* case,² we sustain the rejection of claims

² *See In re Jung*, No. 2010-1019, 2011 WL 1235093 at *7 (Fed. Cir. 2011)(“Jung argues that the Board gave improper deference to the examiner’s rejection by requiring Jung to ‘identif[y] a reversible error’ by

3-10 and 12-19 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Non-Statutory Obviousness-Type Double Patenting Rejection

Claims 1-2

ISSUE

Did the Examiner err in rejecting claims 1 and 2 over claims 1 and 9 of US Patent 7,168,051 (hereinafter ‘051 patent³) and the knowledge of the artisan regarding certain well known features under the doctrine of obviousness-type double patenting?

ANALYSIS

Appellants contend that independent claims 1 and 2 include certain limitations that are not included in claims 1 and 9 of the ‘051 patent and thus, are not obvious in view of claims 1 and 9 of the ‘051 patent. (App. Br. 11). Appellants list the specific limitations that are recited in claim 1 of the present application that are not included in the ‘051 patent. (*Id.*).

The Examiner’s response, however, not only acknowledged the differences between the claims of the present application and ‘051 patent,

the examiner, which improperly shifted the burden of proving patentability onto Jung. *Decision* at 11. This is a hollow argument, because, as discussed above, the examiner established a prima facie case of anticipation and the burden was properly shifted to Jung to rebut it. . . . ‘[R]eversible error’ means that the applicant must identify to the Board what the examiner did wrong”).

³ The Present invention and US Patent 7,168,051 are commonly assigned to ADDnClick, Inc.

but also asserted that the *differences were well-known in the art*. (Ans. 6-7). We note that the Examiner's findings with respect to the well-known limitations were not rebutted by Appellants. Appellants' arguments merely assert that the double patenting rejection was inappropriate because the claims of the present invention include limitations that were not included in the '051 patent. However, we note that the analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. *In re Braat*, 937 F.2d 589 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887 (Fed. Cir. 1985). Here, Appellants have not specifically pointed out the supposed errors in the Examiner's rejection, *which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art*. See MPEP § 2144.03.

Thus, we find Appellants' arguments insufficient to rebut the Examiner's legal conclusion of obviousness, as the Examiner did not apply a statutory double patenting rejection, and also because Appellants have failed to rebut the Examiner's findings regarding certain limitations the Examiner contends were well-known in the art.

On this record, we find that Appellants have not shown reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. Accordingly, we affirm the Examiner's non-statutory obviousness-type double patenting rejection of claims 1 and 2.

Rejections under §103

Claims 1 and 2 rejected as obvious over Mackinlay

CLAIM GROUPING

Based upon Appellants' arguments in the Brief, we select claim 1 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Under §103, did the Examiner err in determining that Mackinlay would have taught or suggested a 3D desktop of a computer system, as recited in claim 1?

ANALYSIS

Appellants contend that “[a]lthough Mackinlay discloses a 3D workspace, such a workspace is not the same as a 3D desktop environment that interfaces the operating system of a computer system and a user.” (App. Br. 13).

We agree with the Examiner that the features argued by Appellants are not recited in claim 1, and we decline to read these limitations into claim 1. (*See* Ans. 28). Moreover, based upon our review of the record, we agree with the Examiner's legal conclusion of obviousness with respect to this limitation. (Ans. 8-10 and 28-29).

Additionally, we agree with the Examiner that Mackinlay would have taught or suggested a 3D “desktop” as claimed, especially in light of the fact that Appellants have not pointed to a particular definition for the term “desktop.” The Examiner accords the term “desktop” its broadest

reasonable interpretation. (*Id.*). Therefore, Appellants have not shown reversible error in the Examiner's determination that Mackinlay would have taught or suggested the claimed 3D desktop.

ISSUE

Under §103, did the Examiner err in determining that Mackinlay would have taught or suggested downloading a 3D environment, executing the 3D development program, accessing a registry server, and storing the downloaded 3D graphical objects as recited in claim 1?

ANALYSIS

The Examiner contends that the disputed limitations of downloading a 3D environment, executing the 3D development program, accessing a registry server, and storing the downloaded 3D graphical objects were well-known in the art. (Ans. 9-13).

Appellants contend that the obviousness of the above-mentioned limitations is not supported by Mackinlay and the limitations at issue are not disclosed or suggested by Mackinlay. (App. Br. 14).

However, the Examiner may take notice of facts or common knowledge in the art which are capable of such instant and unquestionable demonstration as to defy dispute. *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). To challenge the Examiner's notice, Appellants must present evidence to the contrary. *In re Knapp-Monarch Co.*, 296 F.2d 230, 232 (CCPA 1961) (considering challenge to the taking of judicial notice by Trademark Trial and Appeal Board).

Here, the Examiner provided support for the findings that the disputed limitations were well-known in the art. (Ans. 10-13). However, Appellants have not addressed the Examiner's findings with any specificity.

Appellants' arguments merely assert that the disputed limitations were not taught or suggested by Mackinlay and the Examiner did not establish a prima facie case. Appellants' arguments notwithstanding, Appellants have not specifically pointed out the supposed errors in the Examiner's action, *which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.* See MPEP § 2144.03.

Appellants further contend that the Examiner's findings are based upon impermissible hindsight. (App. Br. 15). However, Appellants have not provided any substantive arguments or evidence to support the assertion of impermissible hindsight. We note that attorney arguments and conclusory statements that are unsupported by factual evidence are entitled to little probative value. *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997); *see also In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); and *Ex parte Belinne*, No. 2009-004693, slip op. at 7-8 (BPAI Aug. 10, 2009) (informative), *available at* <http://www.uspto.gov/web/offices/dcom/bpai/its/fd09004693.pdf>.

This reasoning is applicable here. For the aforementioned reasons, we find Appellants' arguments unpersuasive.

ISSUE

Under §103, did the Examiner err in determining that Mackinlay would have taught or suggested an interpreter that

dynamically converts the two-dimensional application program to a form usable in the three-dimensional environment?

FINDINGS OF FACT

2. Mackinlay discloses a processor 102 that is used to convert Web pages into a suitable format for display in the document workspace and interpreting and carrying out movement gestures. (Col. 5, ll. 41-44).
3. Mackinlay discloses a document workspace that is three-dimensional. (Col. 6, ll. 48-49).

ANALYSIS

Appellants contend that Mackinlay's "interpreter" is completely different than the interpreter recited in claim 1. (App. Br. 16). However, based upon our review of the record, we agree with the Examiner's underlying factual findings and ultimate legal conclusion of obviousness regarding this limitation. (Ans. 29-30).

The Examiner mapped the claimed "interpreter" to the "processor" disclosed in Mackinlay. (Ans. 31 and FF 2). We find Mackinlay teaches a document workspace that is three-dimensional. (FF 3). Therefore, we agree with the Examiner that Mackinlay would have taught or suggested the claimed "interpreter" of claim 1. For these reasons, Appellants have not shown reversible error regarding the Examiner's rejection of representative claim 1. Accordingly, we sustain the Examiner's § 103 rejection of claim 1, and claim 2 which falls therewith, over Mackinlay.

Claims 3-8 and 12-17 rejected as obvious over Mackinlay

ANALYSIS

Regarding claims 3-8 and 12-17, we note that Appellants establish a pattern of merely reciting the claim language, followed by a restatement of the Examiner's position, and a conclusory assertion that the Examiner did not establish a prima facie case. Appellants also repeat the assertion that the Examiner's findings are a result of impermissible hindsight. (Cf. App. Br. 16, *et seq.*).

We do not find such arguments sufficient to show reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. *See* n.2 *supra*. *See also* 37 C.F.R. § 41.37(c)(vii) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."). For these reasons, we sustain the Examiner § 103 rejection of claims 3-8 and 12-17 over Mackinlay.

Claims 9-11 and 18-20 rejected as obvious over Mackinlay and Fisher

ANALYSIS

Regarding claims 9-11 and 18-20, we note that Appellants continue the pattern of merely reciting the claim language, followed by a statement of the Examiner's position, and a conclusion that the Examiner did not establish a prima facie case. (App. Br. 24, *et seq.*). Appellants also repeat the assertion that the Examiner's findings are a result of impermissible hindsight. (App. Br. 25). Again, we note that Appellants have not provided any substantive arguments or evidence to support the assertion of impermissible hindsight.

Appellants also attack the teachings of the secondary Fisher reference in isolation. (App. Br. 24, *et seq.*). However, Fisher must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole. *See In re Merck & Co., Inc.*, 800 F.2d 1091, 1097(Fed. Cir. 1986) (one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.).

On this record, we do not find such arguments sufficient to show reversible error in the Examiner's underlying factual findings and ultimate legal conclusion of obviousness. *See n.2 supra*. For these reasons, we sustain the Examiner § 103 rejection of claims 9-11 and 18-20 over the combination of Mackinlay and Fisher.

DECISION

We affirm the § 112, first paragraph, rejection of claims 3-10 and 12-19.

We affirm the obviousness-type double patenting rejection of claims 1 and 2.

We affirm the §103 rejections of claims 1-20.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

ORDER

AFFIRMED

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